

REMARKS

Claims 51-59, and 61-75 were pending in the present application. In the present Office Action, the Examiner rejected Claims 51-59, and 61-75 as allegedly lacking enablement under 35 U.S.C. §112 paragraph 1. In addition, Claims 51-59, and 61-75 were rejected as allegedly being obvious under 35 U.S.C. §103(a) in view of U.S. patent No. 5,650,135 (hereinafter, “the ‘135 patent”), U.S. Patent No.: 6,180,084 (hereinafter, “the ‘084 patent”), and U.S. Patent No.: 6,087,476 (hereinafter, “the ‘476 patent”).

Applicants note that all amendments and canceling of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the amended or canceled Claims (or similar Claims) in the future.

I. Claims 51-59, 61-75 Are Rejected Under 35 U.S.C. § 112 (1)

Claims 51-59, and 61-75 contain subject matter pertaining to amino acid sequences possessing RGD sequence motifs. The Examiner rejects Claims 51-59, and 61-75 under 35 U.S.C. § 112 (1) because “the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims,” Office Action, pg. 2-3, and “as containing subject

¹ 65 Fed. Reg. 54603 (Sept. 8, 2000).

matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention,” Office Action, pg. 5. The Examiner is respectfully directed to page 16 of the Specification which adequately describes a method of creating the present invention. The Examiner is also respectfully directed to Example 1 of the Specification which provides a distinct use of the present invention. As such, the Applicant’s assert that the Specification provides sufficient information for enabling the present invention, and provides adequate written description to generate the present invention. However, to expedite prosecution, Claims 51-59, and 61-75 are now cancelled.

The new Claims 76-98 are amply supported within the Specification (See, e.g., Specification, pg. ²⁶~~18~~; Example 1).

II. Claims 51-59, 61-75 Are Rejected Under 35 U.S.C. §103

The Examiner states “Claims 51-59 and 61-75 are rejected under 35 U.S.C. 103(a) as being obvious over (‘135 patent), in view of (‘476 patent) and further in view of (‘084 patent).” The Applicants respectfully disagree, however, to expedite prosecution, Claims 51-59, and 61-75 are now cancelled.

The new Claims 76-98 are non-obvious. Findings of motivation to combine prior art must be based on objective evidence of record, and not on hindsight reconstruction. In re Sang Su Lee, 277 F.3d 1338, 1342-1343 (Fed.Cir. 2002). In addition, an Examiner must make a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed.Cir. 1999). Here, the Examiner relies upon In re McLaughlin, 170 USPQ 209 (CCPA 1971), and In re Bozek, 163 USPQ 545 (CCPA 1969), as

establishing that "there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." Office Action, pg. 6. To the extent that this 1969 and 1971 C.C.P.A. cases appear to condone hindsight reconstruction when providing a motivation to combine references, the Federal Circuit has *sub silentio* overruled this proposition, and has emphatically stated that hindsight reconstruction is not proper (as detailed below).

The Federal Circuit has repeatedly warned against using hindsight reconstruction as a test of obviousness. A few examples of such cases include: *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"); *Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720 (Fed. Cir. 1990) (The inappropriateness of hindsight as a test of obviousness was, in point of fact, discovered, and articulated lucidly, over three centuries ago, by Milton, who, in *Paradise Lost* Part IV, L. 478-501, stated "The invention all admired, and each how he To be the inventor missed; so easy it seemed, Once found, which yet unfound would have thought, Impossible!"); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068 (Fed. Cir. 1993) ("The motivation to combine references can not come from the invention itself"); *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566 (Fed. Cir. 1996) ("To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction-an illogical and inappropriate process by which to determine patentability"); *W.L. Gore & Assocs., Inc. v. Garlock Inc.*, 721 F.2d 1540 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with the knowledge of the invention in suit, when

no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of hindsight syndrome wherein that which only the inventor taught is used against its teacher ...").

Applicants believe that the present obviousness rejection is based on hindsight and that no motivation exists to combine the cited references. In particular, the Examiner has not pointed to any *evidence* of a motivation to combine the references, but instead has simply stated that the prior art "can" be modified in the articulated manner. This is not the legal standard. The prior art must show that the prior art *should* be modified – not that it could. A statement that something *could* happen is not evidence that it should. The Federal Circuit does not condone hindsight reconstruction, and instead admonishes those who apply such an "illogical" and "inappropriate" process to determine patentability. As such, the Examiner is clearly not entitled to apply hindsight reconstruction to the present Application, and instead must point to some motivation or suggestion to combine in the references themselves.

CONCLUSION

All grounds of rejection of the Office Action of December 31, 2002 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that Applicant's new claims should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

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